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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,542	03/04/2002	Nikolay V. Kuchuk	ICON-001	5528
530	7590	10/06/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			HELMER, GEORGIA L	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/980,542

Applicant(s)

KUCHUK ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group 1, A method for introducing genetic material into plants, comprising: preparing a first plant transformed with a heterologous nucleic acid having 5' and 3' excisable flanking sequences, crossing a second plant to the transgenic first plant, wherein the first and second plants upon crossing, produce unstable progeny is taught by Hadley et. al., in Hybridization of Crop Plants, 1980, American Society of Agronomy, Madison, pages 133-134. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- [a] Claims 1-3, 33-35 and 4, *Tripsacum* and maize.
- [b] Claims 1-3, 33-35 and 5, *Tripsacum* and wheat.
- [c] Claims 1-3, 33-35 and 6, *Tripsacum* and barley.
- [d] Claims 1-3, 33-35 and 7, *Tripsacum* and oat.
- [e] Claims 1-3, 33-35 and 8, *Orychophragmus* and a crucifer.
- [f] Claims 1-3, 33-35 and 9, *Arabidopsis thaliana* and a crucifer.
- [g] Claims 1-3, 33-35 and 10, *Arabidopsis thaliana* and canola.
- [h] Claims 1-3, 33-35 and 11, *Glycine tomentella* and soybean.
- [i] Claims 1-3, 33-35 and 12, *Solanum phreja* and potato

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- [j] Claims 1-3, 33-35 and 13, maize and wheat.
- [k] Claims 1-3, 33-35 and 14 maize and barley.
- [l] Claims 1-3, 33-35 and 15, maize and oats.
- [m] Claims 1-3, 33-35 and 16, Pennisetum and wheat
- [n] Claims 1-3, 33-35 and 17, Pennisetum and barley.
- [o] Claims 1-3, 33-35 and 18, Hordeum bulbosum and barley.
- [p] Claims 1-3, 33-35 and 19, Hordeum bulbosum and wheat.
- [q] Claims 1-3, 33-35 and 20, Oryza minuta and rice.
- [r] Claims 1-3, 33-35 and 21, N. glauca and N. tabacum.
- [s] Claims 1-3, 33-35 and 22, cotton carrying a Somatic embryo mutation.
- [t] Claims 1-3, 33-35 and 23, soybean carrying a mus mutation.
- [u] Claims 1-3, 33-35 and 24, where the first plant is Arabidopsis thaliana.

or

Group II, A method for introducing genetic material into plants, comprising:  
preparing a first plant transformed with a heterologous nucleic acid having 5' and 3' excisable flanking sequences, fusing a cell or protoplast with a cell of a second plant a second plant to the transgenic first plant, wherein the first and second plants upon crossing, produce unstable progeny.

- [aa] Claims 25 –29, 33-36, and 30, Arabidopsis and cotton.
- [bb] Claims 25 –29, 33-36, and 31, Arabidopsis and soybean.
- [cc] Claims 25 –29, 33-36, and 32, Arabidopsis and rice

Thus Applicant should choose either Group I or Group II. If Group I is chosen , select one of [a] to [u]. If Group I is chosen , select one of [aa] to [cc].

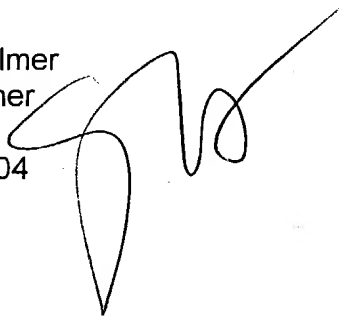
2. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0976. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia L. Helmer  
Patent Examiner  
Art Unit 1638  
October 1, 2004

A handwritten signature in black ink, appearing to be 'G. Helmer', written over the printed name and date.